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10/805,229	03/22/2004	Yasuhiro Hashimoto	204552032100	9032
7590 Barry E. Bretschneider Morrison & Foerster LLP Suite 300 1650 Tysons Boulevard McLean, VA 22102				
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EXAMINER STOREY, WILLIAM C				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/805,229

**Applicant(s)**

HASHIMOTO, YASUHIRO

**Examiner**

WILLIAM C. STOREY

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Note***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/5/2008 has been entered.

### **Claim Rejections - 35 USC § 112**

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 8, and 15 (and dependents) are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is claimed that the first job includes a template. However, it has not been disclosed how the job itself includes the template (internal to the job). The specification repeats and superficially mentions similar wording to the claim language, but has not provided an enabling and specific disclosure for the inclusion of the template in the job. Rather, the specification discusses including a

template (embodied as serial numbers, for example) in the job file name (external to the job, rather than included in the job).

3. Claims 1, 8, and 15 (and dependents) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains material which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the invention was filed. A patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed to put the public in possession of what the applicant claims as the invention. Further, the written description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. It is claimed that the first job includes a template. However, it has not been disclosed how the job itself includes the template (internal to the job). The specification repeats the claim language, but has not provided an enabling and specific disclosure for the inclusion of the template in the job. Rather, the specification discusses including a template (embodied as serial numbers, for example) in the job file name (external to the job, rather than included in the job).

4. Claims 3 & 10 (and dependents) are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s)

contains material which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the invention was filed. A patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed to put the public in possession of what the applicant claims as the invention. Further, the written description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. Claim 1 claims that the first job includes a template which indicates that a plurality of files are to be merged. However, in claim 3, it is claimed that the same template included in one job comprises serial numbers set for over a plurality of the files. However, this is in contradiction with the description provided by the specification. Reference to Fig. 3 depicts the serial numbers set for over a plurality of files that are in different jobs (fig. 3, ¶42).

5. Claims 4 & 11 (and dependents) are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains material which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the invention was filed. A patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the

inventor's obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed to put the public in possession of what the applicant claims as the invention. Further, the written description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. Claim 1 claims that the first job includes a template which indicates that a plurality of files are to be merged. However, in claim 4, it is claimed that the same template comprises a pair of a first symbol indicating that a file contained in one job is temporarily stored in the storage section and a second symbol indicating that files temporarily stored in the storage section are merged and printed. This would require the first job to contain both of these symbols. However, this is in contradiction with the description provided by the specification. Reference to Fig. 3 depicts the two symbols applied across multiple jobs (screen a.jpg, screen b.jpg), rather than included in one job (fig. 3, ¶50).

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 8, and 15 (and dependents) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The specification describes two inconsistent definitions of "template." It is first stated that the "template" refers to an instruction set for over a plurality of jobs according to specified rules to merge and print

a plurality of files. (¶41) Then, the specification claims that "the template is serial numbers of (1/3) (2/3) (3/3) set for over three files" (¶42). This specifies one template that spans over three files. Hence, it would be impossible to have such a template included in the first job (as claimed, such as in the independent claims) when the template spans over multiple files. In addition, the specification then goes on to refer to "the template (1/3)," "the template (2/3)", etc., and "these templates." These are multiple templates for the three files. These multiple definitions are inconsistent with each other, and do not coherently in tandem support the language within the claim. In addition, in ¶50, this contradiction is bleakly provided in the declaration "***the template is a pair of a template*** (TMP) as a first symbol ***and a template*** (PRT) as a second symbol set for over two files" (emphasis added). Thus, it is unclear and indefinite as to exactly what definition, or to what, a "template" refers in the context of the claim.

8. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In order to construe the same interpretation as previously directed before the amendment for the last non-final, the examiner assumes that the terminal is instructing and the printing section executing. In order to reduce any possibility over the ambiguity of whether the network may now be construed to perform these actions, the examiner suggests rewriting the claim limitations previously-referred in such a fashion: "a terminal connected to a network; the terminal for instructing" and "a printing section connected to the network; the printing section for executing printing."

However, as this issue was not addressed when previously brought up, it renders the claim indefinite and/or subject to the possibility new matter.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 7-8, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Catt et al. (US 20030007167), hereinafter referred to as Catt.

Regarding claim 1, Catt discloses a template determination section configured to determine, upon reception of a first job including a first file to be printed, whether or not the first job includes a template which indicates that a plurality of files including the first file and a second file are to be merged, wherein the second file is included in a second job; ¶59 details that an imposition template (fig. 6, 100) (first job including a first file to be printed) is transmitted to be printed. ¶59 details how the system extracts information such as sequencing, orientation, etc. For imposition, this details how pages (plurality of files other than first) are laid out on the first. In the context of the invention, this details how the plurality of files (such as a second file) are to be merged with the template, as shown in fig. 6. ¶62 discloses separate submission of page images, one of the page images may read on claimed second file included in a second job.)

a job holding section configured to store the first job in a storage section when it is determined by the template determination section that the first job includes the template



(¶56, ¶59. It would have been at least obvious to one of ordinary skill in the art at the time the invention was made to provide storing the first job in a storage section based on the a determination by the template determination section that the first job includes the template for the purpose of providing greater flexibility and/or efficiency. If a user just wanted to print one page without regard to a template, he or she may do so without waiting with storage. However, storage would be justified in order to assemble the merged product. Storage based upon the determination thus would provide greater flexibility and/or efficiency.);

a template analysis section configured to determine, based on the template, whether or not all jobs including the plurality of files to be merged are stored in the storage section (fig. 6, ¶56, ¶59, ¶62 show the template having information detailing layout of the page image jobs on the template. It is disclosed how the press sheet is assembled after the page images are processed by the RIP and stored on the print drive until the output is ready. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a template analysis section configured to determine, based on the template, whether or not all jobs including the plurality of files to be merged are stored in the storage section for the purpose of providing greater robustness, awareness, and/or efficiency. If the template requires the page images and they are not available, it is a benefit for the system to be aware of this fact so as not to waste extra processing time require when the system would have to deal with a missing image for the template layout).; and

a control section configured to exert control based on the template so as to merge and print the plurality of files contained in all the jobs when it is determined by the template analysis section that all the jobs are stored in the storage section (Again, from the benefits discussed just prior, it would have been obvious to control the processing to provide greater robustness, awareness, and/or efficiency.)

Regarding claim 7, the claim inherits everything as applied above for claim 1. ¶45 discloses an input network interface module which may read on the claim.

Regarding claim 8, the claim is rejected based upon similar reasoning as applied above for claim 1. Changing the claim from one category of invention to another does not make the claim patentably distinct.

Regarding claim 14, the claim is rejected based upon similar reasoning as applied above for claim 8. Changing the claim from one category of invention to another does not make the claim patentably distinct.

Regarding claim 15, claim 15 is rejected under many of the same reasoning as applied for claim 1, nay a few distinctions. ¶45-46 describe network communications in order to transmit the jobs to be output. Inherently, there must be a terminal connected to the network configured to instruct a first job including a first file to be printed in order to accomplish the described procedures, and those previously described. ¶48 discloses a printer as and output device for the previously-described procedures. In addition, it is inherent that there be an instruction or control to execute the printing. These discussions in conjunction with the previously-disclosed and presented discussions provide for the limitations of the claim.

11. Claims 2-5, 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the previous disclosures as applied to claim 1 above, and further in view of Dimperio et al. (US 6965445), hereinafter referred to Dimperio; and/or Kuntz et al. (6498657), hereinafter referred to as Kuntz.

Regarding claim 2, the claim inherits everything as applied above for claim 1. The template for the discussion regarding this claim may simply be a reference to the fact that a plurality of files are to be merged, as previously claimed. Although Catt did not distinctly disclose wherein the template is included in a job name, it would have been obvious to one of ordinary skill at the time the invention was made to provide the template included in a job name for the purpose of providing greater awareness. A user may read information in the file name that indicates a file is to be merged (thus, reading on claimed template, in context). Inherently, every file or data or job has some sort of name for reference.

Further, it is well known to put job-related information in a job name. Dimperio discloses the use of file names that contain an embedded text and/or numerical string in order to correspond to a job ticket and outputting a document based on the job ticket instructions, which reads on claimed template; located in the file name, which reads on claimed job name; as disclosed in the claims. For example, col. 3, lines 41-47 shows an example of the filename's correspondence with job instructions. It has similarly been described how the imposition template references particular instructions for a merged job set up (Catt, ¶59). Just as a job may pertain to multiple files, a merged job may pertain to multiple jobs. It would have been obvious then to simply put a template

reference to such instructions in the job name in order to provide greater awareness as previously discussed.

Further, for extra support, Kuntz discloses interpreting strings of characters and/or numbers in order to provide, work with, and/or merge data with a template (abstract, col. 2, lines 59-67, col.3, lines 1-13). Thus, some sort of trigger string, etc. may read upon claimed "template" in that it refers to a template or provides information with respect to the template (for more information, col. 16, lines 22-37). The template may reference other files and/or text, etc. to be inserted into the template (col. 12, lines 28-47, col. 14, lines 56-61, col. 17, lines 5-10, col. 20, lines 66-67, col. 21, lines 1-5, col. 21, lines 10-14). Multiple files may be merged in various ways (for example, previous citations and/or col. 25, lines 11-17). Kuntz provides means for analyzing strings of numbers and/or characters, interpreting that information with respect to templates, or interpreting the information in a job to be a template, as well as the ability to merge files and/or text, information, etc. This shows the ability to provide by a simple string, reference to instructions, such as a template. Thus, the string could easily be provided in a job name in order to provide greater awareness. In addition, Dimperio has shown interpreting strings located in file (similarly, job) names. This would allow a user to have a better understanding of the purpose and/or contents of the job, rather than if no such indicating information (template) were provided within the job name.

Regarding claim 3, the claim inherits everything as applied above for claim 1. In addition, support provided in claim 2 will be used for the discussion regarding claim 3. Dimperio discloses parameters, which reads on claimed template; of a job ticket defined

as numerical values, which reads on claimed serial numbers; as disclosed in column 5, lines 4-8. One example of a possible parameter is page numbering, which reads on claimed set for over a plurality of pages; as disclosed at column 6, lines 40-41. However, Dimperio discloses that any parameter may be described, as disclosed at column 6, 38-41. In addition, Kuntz discloses the interpreted commands being represented by serial numbers (col. 6, lines 50-51, col. 23, lines 42-44, col. 23, lines 46-48). It would have been obvious to provide the template comprising serial numbers set for over a plurality of the files in order to reduce job name length and provide greater simplicity, as well as versatility. Setting it over the plurality of files would provide for greater flexibility and/or control.

Regarding claim 4, the claim inherits everything as applied above for claim 1. In addition, much of the discussion provided with respect to claims 2 and/or 3 will be relied upon. It has been described previously how pages that are to go on an imposition template are held and stored until they are ready to be output (§§56, 62). Similarly, the imposition template may be stored in advance of its output (§§57, 59), so that it may be used without having to transfer it multiple times, and/or allowing for greater robustness and/or flexibility, such as in the case there were transfer problems or issues concerning the necessary pages. Understandably, there would be some command in order to control storage of jobs necessary and to merge and print the stored files. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the template comprising of a pair of a first symbol indicating that a file contained in one job is temporarily stored in the storage section and a second symbol indicating

that the files temporarily stored in the storage section are merged and printed for the purpose of providing control and assurance over such actions. The commands may be embodied as symbols that are interpreted, as discussed previously by Dimperio and/or Kuntz, and may be embodied in the template as discussed for claim 1, or in a job name as discussed for claim 2. It would have been at least obvious to do so, by providing simplicity, greater awareness, and/or repeatable interpretation by having the actions represented by symbols. By placing them in a job name, it would provide greater awareness.

Regarding claim 5, the claim inherits everything as applied above for claim 1. In addition, the discussion provided for claim 2 may be relied upon. Dimperio provides that it is well known for jobs to direct an output to be single-sided or double sided (at least one of double-sided printing, etc.). Such designation is a specific print process instruction. It would have been obvious to designate such a specific print process with the jobs in order to provide greater flexibility and/or control.

Regarding claim 9, the claim is rejected based upon similar reasoning as applied above for claim 2. Changing the claim from one category of invention to another does not make the claim patentably distinct.

Regarding claim 10, the claim is rejected based upon similar reasoning as applied above for claim 3. Changing the claim from one category of invention to another does not make the claim patentably distinct.

Regarding claim 11, the claim is rejected based upon similar reasoning as applied above for claim 4. Changing the claim from one category of invention to another does not make the claim patentably distinct.

Regarding claim 12, the claim is rejected based upon similar reasoning as applied above for claim 5. Changing the claim from one category of invention to another does not make the claim patentably distinct.

12. Claims 6, 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over the previous disclosures as applied to claim 1 above, and further in view of Suzuki (US 5878196).

Regarding claim 6, the claim inherits everything as applied above for claim 1. It would have been obvious to one of ordinary skill at the time the invention was made to provide printing of the jobs executed in compliance with a specific print processing instruction contained in a last received job among all the jobs. Inherently, there is some print processing instruction to execute printing. Waiting until after all the processed jobs have been fully received is necessary for adequate printing, and thus, it would have been obvious to provide that the printing occur after the last processed and ready job is provided in order to provide the desired and accurate print, in the most efficient manner.

Further, in a similar field of endeavor, Suzuki discloses a printer controller system. In addition, Suzuki discloses a job waiting in a reception waiting queue. When a job is received that contains the last of necessary documents for the job in the reception waiting queue, the waiting job is transferred to the printer queue for printing as

disclosed at column 6, lines 7-11. It would have been obvious to implement such a feature in order to provide greater system robustness and/or efficiency.

Regarding claim 13, the claim is rejected based upon similar reasoning as applied above for claim 8. Changing the claim from one category of invention to another does not make the claim patentably distinct.

### ***Response to Arguments***

13. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM C. STOREY whose telephone number is (571)270-3576. The examiner can normally be reached on Monday - Friday Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Y. Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William C Storey/  
Examiner, Art Unit 2625

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